

Claims 1 - 3, 26, and 27

Applicant respectfully submits that the rejection fails because Hill fails to identically show all of the elements of claim 1. For instance, Hill fails to identically show, among other things, pacing based on a first indicated pacing interval as recited in claim 1. In contrast, Applicant notes that Hill relates to delivery of pacing based on an average "calculated over the three cycles ending before the cycle in which the most recent depolarization was sensed." Hill, Col. 3, Lines 60 - 65.

Claims 2, 3, 26, and 27 contain additional limitations to a patentable base claim. Reconsideration and allowance of claims 1 - 3, 26, and 27 is respectfully requested.

Claims 58 and 59

Applicant respectfully submits that the rejection fails because Hill fails to identically show all of the elements of claim 58. For instance, Hill fails to identically show, among other things, providing pacing therapy based on a first indicated pacing interval as recited in claim 58. Applicant notes that, in contrast to claim 58, Hill relates to delivery of pacing based on an average "calculated over the three cycles ending before the cycle in which the most recent depolarization was sensed." Hill, Col. 3, Lines 60 - 65.

Claim 59 contains additional limitations to a patentable base claim. Reconsideration and allowance of claims 58 and 59 is respectfully requested.

Claims 63 and 88

Applicant respectfully submits that the rejection fails because Hill fails to identically show all of the elements of claim 63. For instance, Hill fails to identically show, among other things, a first register for storing a first indicated pacing interval as recited in claim 63.

According to the Office Action at Page 3, Paragraph 4, Line 3, Hill does not disclose the register.

Applicant agrees that Hill fails to show the register. Reconsideration and allowance of claim 63 is respectfully requested.

Claim 88 contains additional limitations to a patentable base claim. Reconsideration and

allowance of claims 63 and 88 is respectfully requested.

Claim 91

Applicant respectfully submits that the rejection fails because Hill fails to identically show all of the elements of claim 91. For instance, Hill fails to identically show, among other things, a first register for storing a first indicated pacing interval as recited in claim 91.

According to the Office Action at Page 3, Paragraph 4, Line 3, Hill does not disclose the register.

Applicant agrees that Hill fails to show the register. Reconsideration and allowance of claim 91 is respectfully requested.

§103 Rejection of the Claims

In the Office Action, claims 23 - 25, 64 and 67 - 70 were rejected under 35 USC § 103(a) as being unpatentable over Hill (U.S. Patent No. 5,814,085). Applicant respectfully traverses the rejections on several grounds. The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). It is submitted that the Office Action has not established a *prima facie* case of obviousness.

- 1. A *prima facie* case of obviousness has not been established because all of the elements are not shown by the cited patents.**

To establish a *prima facie* case of obviousness, a prior art reference must teach **all** of the claim limitations. (Emphasis added). MPEP § 2143, *In re Royka*, 490 F.2d 981 (CCPA 1974). Applicant submits that the rejection has not established a *prima facie* case of obviousness since the rejection has not shown that each element is taught by the cited patents.

Claims 23 - 25

Applicant incorporates the above discussion of claim 1 herein. It is respectfully submitted Applicant is unable to find in the cited patents, among other things, pacing based on first

indicated pacing interval as recited in claim 1, from which claims 23 - 25 depend. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). These dependent claims include additional limitations to patentable claim 1. In addition, Applicant submits that the dependent claims are allowable as having the patentable limitations of the base claim, as discussed above.

Claims 64, 67 - 70

Applicant incorporates the above discussion of claim 63 herein. It is respectfully submitted Applicant is unable to find in the cited patents, among other things, a register as recited in claim 63, from which claims 67 - 70 depend. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). These dependent claims include additional limitations to patentable claim 63. In addition, Applicant submits that the dependent claims are allowable as having the patentable limitations of the base claim, as discussed above.

Applicant respectfully submits that the Office Action fails to establish all of the elements of claims 23 - 25, 64, 67 - 70, and requests reconsideration and allowance.

2. The Office Action fails to establish a *prima facie* case of obviousness because there is legally insufficient motivation to combine the cited patents.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In order for such a conclusion to be reached, either 1) an objective teaching in the prior art suggests that the combination of the elements may lead to the advantageous result, or 2) it is well-known in the art that such a combination would lead to the result. *Id.* The court in *Fine* stated that obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). However, it "cannot be established by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion supporting the**

combination." (emphasis added). *ACS Hosp. Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984). Combination of the teachings of references can only occur if there is some suggestion or incentive to do so. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

According to the Office Action, "it would have been obvious to one having ordinary skill in the art . . . to modify the . . . device as taught by Hill . . . since it was known in the art that pacemakers include sensors, registers, and base the pacing therapy on a second pacing interval based on the sensors, base the pacing therapy on the shorter of the two intervals, and provide a bounded range for the intervals to provide the pacer with other indicators of physiological demand so the pacer can control the pacing rate with a combination of the other indicators and limit the pacing rate to selected rates." Page 3, Office Action. However, the Office Action fails to establish why one would be motivated to modify Hill "to provide the pacer with other indicators of physiological demand so the pacer can control the pacing rate with a combination of the other indicators and limit the pacing rate to selected rates." Applicant respectfully traverses and submits that the Office Action fails to provide sufficient motivation to modify the patents as suggested. Unless relying on impermissible hindsight reconstruction, the Office Action appears to be taking Official Notice, which is timely traversed under MPEP 2144.03, and if the Examiner is aware of a reference providing support of the assertion, citation of the reference is respectfully requested.

In addition, the Office Action asserts that "it would have been an obvious matter of design choice to one skill in the art, to use an IIR, FIR, or weighted averager for the filter, since applicant has not disclosed that . . . [it] provides any criticality and/or unexpected results." Page 4, Office Action. Applicant is unaware of a requirement that an Applicant has the burden to demonstrate criticality or unexpected results. Instead, it is the Examiner who has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In order for such a conclusion to be reached,

either 1) an objective teaching in the prior art suggests that the combination of the elements may lead to the advantageous result, or 2) it is well-known in the art that such a combination would lead to the result. *Id.* The court in *Fine* stated that obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). However, it "cannot be established by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion supporting the combination.**" (emphasis added). *ACS Hosp. Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984). Combination of the teachings of references can only occur if there is some suggestion or incentive to do so. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Reconsideration and allowance is respectfully requested.

3. The Office Action fails to establish a *prima facie* case of obviousness because the Office Action fails to examine the claims as a whole.

The discussion of claims 23 - 25, 64, 67 - 70 on pages 3 and 4, the rejection appears to be discussing whether the differences themselves between the patents and the claims are obvious, instead of examining the claimed invention as a whole, as required by *Stratoflex, Inc. v. Aeroquip Corp.*

For example, for the rejection of claims 23 - 25, 64, 67 - 70, the Office Action on page 3 states "it would have been obvious to one having ordinary skill in the art . . . to modify the . . . device as taught by Hill with the sensor, register, and basing the pacing therapy on a second pacing interval based on the sensor, basing the pacing therapy on the shorter of the two intervals, and providing a bounded range for the intervals." In contrast, for example, claim 23 clarifies that providing pacing therapy is also based on a second indicated pacing interval that is based on a sensor *in combination with all of the elements of claim 1*. It is this new combination which the Office Action fails to address and fails to establish as being taught by the cited patents.

Applicant traverses the rejections and requests reconsideration and allowance of the rejected claims. Furthermore, dependent method claims are discussed collectively with dependent apparatus claims. The underlying base claim for each is different, and form a separate, new combination with their respective dependent claims.

In obviousness determinations, the question is whether the claimed invention as a whole would have been obvious, and not whether the differences themselves would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Applicant submits that the rejected claims, as a whole, provide an invention which is not taught in the cited patent.

In view of the foregoing, reconsideration and allowance of the pending claims is respectfully requested.

Allowable Subject Matter

Applicant acknowledges the allowance of claims 28 - 57 and 90.

Claims 4 - 22, 60 - 62, 65 and 71 - 87 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

AMENDMENT & RESPONSE UNDER 37 C.F.R. § 1.116 - EXPEDITED PROCEDURE

Serial Number: 09/316,515

Filing Date: May 21, 1999

Title: METHOD AND APPARATUS FOR TREATING IRREGULAR VENTRICULAR CONTRACTIONS SUCH AS DURING ATRIAL ARRHYTHMIA

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Dkt: 279.112US1

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612 359-3276) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

DAVID B. KRIG ET AL.

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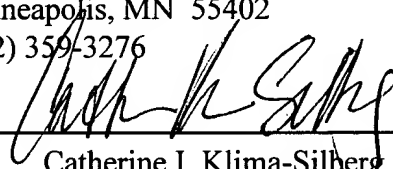
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Box RCE, Commissioner of Patents, Washington, D.C. 20231, on this 4th day of June, 2001.

Name

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